10-24-05 Af/3624 DRW

TRANSMITTAL OF APPEAL BRIEF	Docket No. 65678-0004

In re Application of: Andrew F. Suhy et al.

Application No.	Filing Date	Examiner	Group Art Unit
09/504,000-Conf. #7392	February 14, 2000	J. Patel	3624

Invention: SYSTEM AND METHOD FOR MODELING A SIMULATED FLEET OF ASSETS

TO THE COMMISSIONER OF PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: July 9, 2003 .

The fee for filing this Appeal Brief is _____ .

☐ Large Entity ☐ Small Entity

☐ A petition for extension of time is also enclosed.

The fee for the extension of time is _____ .

☐ A check in the amount of _____ is enclosed.

☐ Charge the amount of the fee to Deposit Account No. _____ .
This sheet is submitted in duplicate.

☐ Payment by credit card. Form PTO-2038 is attached.

☒ The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. 18-0013 .
This sheet is submitted in duplicate.

Dated: October 21, 2005

Charles A. Bieneman
Attorney Reg. No.: 51,472
RADER, FISHMAN & GRAUER PLLC
39533 Woodward Avenue
Suite 140
Bloomfield Hills, Michigan 48304
(248) 594-0633

Appeal Brief Transmittal

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV509982715 US, in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: October 21, 2005 Signature: (Lisa M. Terry)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	PARENT, et al.		
Serial No.:	09/504,000	Group Art Unit :	3624
Filed:	02/14/2000	Examiner:	Patel, Jagdish
For:	SYSTEM AND METHOD FOR MODELING A SIMULATED FLEET OF ASSETS		

Attorney Docket No.: 65678-0004 (DCCIE 5297)

Commissioner for Patents
Mail Stop Appeal Brief - Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being:

☒ deposited with the United States Postal Service

__ **first class mail**, postage prepaid in an envelope addressed to MS Appeal Brief - Patents, P.O. Box 1450, Alexandria, VA 22313-1450

☐ transmitted by facsimile to the Patent and Trademark Office to Examiner _____ at 571-273-0053 (fax number)

Lisa M. Terry
Signature

Date: October 21, 2005

Lisa M. Terry
Name

REPLY BRIEF

Dear Sir:

This appeal is from the decision of the Primary Examiner dated July 22, 2005 (hereinafter the "Office Action"), rejecting claims 1-22 in the above-identified application, raising new grounds for the rejections in an attempt to reopen prosecution despite the fact that Applicant's Appeal Brief was filed two years ago. Upon review of the new grounds, no amendments were deemed necessary. In particular, the attempt to now, and in an untimely manner, assert 35 U.S.C. § 101 after five years of prosecution is particularly telling. Only three (3) of the claims out of twenty-two (22) claims are rejected on grounds other than § 101.

Applicants (hereafter "Appellants") respectfully again request consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the present patent application referenced above. Submitted herewith are two additional copies of this Reply Brief. An oral hearing is not desired.

I. REAL PARTY IN INTEREST

The Real "Party-In-Interest" is Dana Corporation, located at 4500 Dorr Street, P.O. Box 10000, Toledo, Ohio 43697. Dana Corporation was assigned all rights to the U.S. Patent Application identified by Serial No. 09/504,000 on May 15, 20003 by Dana Commercial Credit Corporation of 660 Beaver Creek Circle, Maumee, Ohio 43537.

II. RELATED APPEALS AND INTERFERENCES

On July 9, 2003, Appellants filed a Notice to Appeal the final rejection of U.S. Application Serial Number 09/504,000, filed February, 14, 2000 as a C-I-P application claiming priority from application 09/441,289. On September 9, 2003, Appellants filed an Appeal Brief. On July 22, 2005, the Office mailed a new rejection (hereinafter the "Office Action") of all pending claims (claims 1-22). This Appeal is taken from the Examiner's non-final rejection in the above-identified application.

On July 9, 2003, Appellant also filed a notice of appeal, and on September 9, 2003 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/441,289. On January 7, 2005, this Board issued a decision reversing the Examiner's rejection of all pending claims (claims 16 and 21-48). Pursuant to 37 C.F.R. § 41.37(c)(1)(ii), a copy of the afore-mentioned decision of this Board is attached hereto as Appendix C. The application at issue in this appeal is a C-I-P application claiming priority from application 09/441,289.

On December 12, 2003, Appellant filed a notice to appeal, and on February 12, 2004 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial Number 09/653,735, filed September 1, 2000 as a C-I-P application claiming priority from the following applications: U.S. Application Serial No. 09/441,289 filed November 16, 1999; U.S. Provisional Application Serial No. 60/166,042 filed November 17, 1999; U.S. Application Serial No. 09/503,671 filed February 14, 2000; U.S. Application Serial No. 09/504,000 filed February 14,

2000; and U.S. Application Serial No. 09/504,343 filed February 14, 2000. On April 26, 2005, this Board issued a decision reversing the Examiner's rejection of all pending claims (claims 1-8 and 12-24). Pursuant to 37 C.F.R. § 41.37(c)(1)(ii), a copy of the afore-mentioned decision of this Board is attached hereto as Appendix D.

On December 12, 2003, Appellant filed a notice of appeal, and on February 12, 2004 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/702,363, filed October 31, 2000 as a C-I-P application claiming priority from application 09/441,289.

On October 9, 2003, Appellant filed a notice of appeal, and on December 9, 2003 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/504,343, filed February 14, 2000 as a C-I-P application claiming priority from application 09/441,289.

On May 4, 2004, Appellant filed a notice to appeal, and on July 1, 2004 Appellant filed an Appeal Brief, appealing to the final rejection of U.S. Application Serial No. 09/714,702, filed November 16, 2000 as a C-I-P application claiming priority from application 09/441,289.

On March 16, 2005, Appellant filed a notice to appeal the final rejection of U.S. Application Serial No. 09/990,911, filed November 14, 2001 as a C-I-P application claiming priority from application 09/441,289.

On October 24, 2003, Appellant filed a notice to appeal the final rejection of U.S. Application Serial Number 09/503,671, filed February 14, 2000 as a C-I-P application claiming priority from application 09/441,289. On November 25, 2003, after Appellant had filed the afore-mentioned notice of appeal, the Office mailed a new final rejection of all claims. In response, Appellant submitted an Amendment Pursuant to 37 C.F.R. §1.116 on January 20, 2004, and a Notice of Appeal, dated February 20, 2004. An Advisory Action was mailed on February 2, 2004. Appellant subsequently filed an Appeal Brief on April 20, 2004.

III. STATUS OF CLAIMS

Claims 1-22 are pending, and are the subject of this Appeal. Claims 1, 16, 19, and 22 are independent claims. The original claims 1-21 have not been amended during prosecution of this patent application. Claim 22 was added with the amendment mailed May 12, 2003. In the

Office Action, claims 1-22 were rejected under 35 U.S.C. § 101 for allegedly failing to recite statutory subject matter. Claims 1, 2, and 22 were further rejected under 35 U.S.C. § 102(a) as being allegedly unpatentable over Pisula et al. (WO 99/06934) ("Pisula"). Additionally, claim 22 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Pisula alone.

IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection. A copy of all claims on appeal is attached hereto as an Appendix.

V. SUMMARY OF CLAIMED SUBJECT MATTER

By way of background, the field of industrial equipment, such as forklifts, includes business entities at several different levels, including manufacturers, dealers, third-party financiers, and end-user customers. In one common arrangement, the dealer maintains an inventory of a wide variety of equipment types for rental to its end-user customers (i.e., the dealer's "rental fleet"). Some types of equipment in the dealer's rental fleet, however, are only infrequently needed by the dealer's end-user customers. Accordingly, such seldomly used items experience a reduced utilization rate compared to other items in the rental fleet. The dealer tolerates reduced utilization of the seldomly used items for a number of reasons, including maintaining customer satisfaction, and, hopefully, not giving the customer a reason to "shop around" for a new dealer who may have larger inventory of seldomly used pieces of equipment. Conventional methods of conducting business, particularly providing rental fleets, have obvious shortcomings, inasmuch as the full economic value of some items in the dealer's rental fleet cannot be realized.

Another common business arrangement involves a third-party financing company that buys pieces of industrial equipment from the manufacturer and then leases the equipment to the end-user customer. The customer then utilizes the industrial equipment (the customer's "fleet") in its business. In some circumstance, the customer actively "manages" the fleet of industrial equipment, attending to repair and maintenance, the acquisition of replacement equipment, and the retirement of old or unproductive equipment from the fleet. In other circumstances, however, the leasing company performs the asset management function. In either set of circumstances, challenges to be overcome by fleet managers include how to effectively and efficiently

determine the timing, selection, and acquisition of replacement equipment, and the disposal of equipment being retired from the fleet or coming to an end of the lease term.

Known approaches to deal with the foregoing challenges fall mostly into the use of manual methods. For example, determining whether to replace a poorly performing piece of equipment has typically been based on limited data relating to the equipment known by an experienced fleet manager.

One known approach for asset management pertains to passenger vehicle fleets and involves a computer-based, Internet-enabled vehicle selector program. The vehicle selector program provides average values for a plurality of different operating parameters and vehicle types that may be of interest to a fleet manager considering vehicle replacement. These parameters may include average monthly maintenance cost, and average miles per gallon.

In one aspect of the present invention, an electronic system for modeling a simulated fleet is provided. The capability to model a simulated or "fantasy" fleet of assets provides the user with an effective and efficient mechanism to perform "what if" analyses. The user can then use the results to evaluate what effect proposed changes to an existing fleet would have on overall fleet performance. The electronic system for modeling a simulated fleet includes a simulated fleet configuration unit, a reporting and analysis module, and a communications interface.

The simulated fleet configuration unit is provided for allowing a user to add a plurality of assets to the simulated fleet. Each asset is defined as having at least one parameter associated therewith. For example, in one embodiment, the parameter may be a total hourly cost to operate the asset. The reporting and analysis module is configured to generate a report having a composite output value that corresponds to the parameter, and, is characteristic of all of the assets in the simulated fleet. For example, the composite output value may be a composite total hourly cost for all the assets in the simulated fleet. Finally, the communications interface is configured to facilitate electronic remote access of the system by the user. For example, in a preferred embodiment, the communications interface allows access to the system over the Internet. This reduces the time and effort to obtain information. The system, according to this aspect of the present invention, provides a more effective asset management tool than available using conventional systems.

In a preferred embodiment, some of the assets contained in the simulated fleet correspond to assets already contained in the user's existing fleet. The remainder of the assets in the

simulated fleet correspond to new or used assets proposed for acquisition by the user. The report generated by the reporting and analysis module contains a composite output value representative of all the assets in a simulated fleet, namely, both the existing assets, and the proposed assets to be acquired. The report may be compared to a second report generated based on the performance of the assets in the existing fleet alone. Comparison of the two reports by the user allows accurate evaluation of the impact of the proposed changes.

VI. ISSUED PRESENTED

1. Whether claims 1-22 are patentable under 35 U.S.C. § 101.
2. Whether claims 1, 2, and 22 are patentable under 35 U.S.C. § 102(a) over Pisula.
3. Whether claim 22 is patentable under 35 U.S.C. § 103(a) over Pisula.

VII. ARGUMENT

A. Claims 1-22 Are Patentable Under 35 U.S.C. § 101.

i. Summary

The Examiner for the very first time, and in a very untimely manner, attempted to reject claims 1-22 under 35 U.S.C. § 101 as being non-statutory subject matter. Appellants' claims plainly recite systems and methods that produce useful, concrete, and tangible results and therefore, are clearly patentable under Section 101. *See State Street Bank & Trust Co. v. Signature Financial Group, Inc.,* 149 F.3d 1368, 1375 (Fed. Cir. 1998). Appellants respectfully traverse the rejection and although Appellants believe the rejection improper, the Examiner's reasoning for the § 101 rejection has been fully addressed in an effort to expedite prosecution. Accordingly, for any of the foregoing reasons, the Examiner's rejection of claims 1-22 under § 101 should be reversed.

ii. The Law

Whether an invention is operative, and hence has utility within the meaning of § 101, is a question of fact. *In re Swartz*, 232 F.3d 862, 863 (Fed. Cir. 2000). The Patent Office establishes a *prima facie* case of lack of utility by "showing that one of ordinary skill in the art would reasonably doubt the asserted utility[.]" *In re Brana*, 51 F.3d 1550, 1566 (Fed. Cir. 1995) (Discussing § 101 and § 112 rejections in detail with respect to utility requirements). The

Federal Circuit has held that ideas that produce a "useful, concrete, and tangible result," are patentable. *State Street Bank & Trust Co. v. Signature Financial*, 149 F.3d 1368, 1373 (Fed. Cir. 1998). In the first instance, the Examiner must establish that a person of ordinary skill in the art would reasonably doubt the asserted utility. *Brana*, 51 F.3d at 1566. Then, the burden shifts to the Applicant to substantiate their presumptively correct disclosure. *Brana*, 51 F.3d at 1566-1567.

However, "[t]he inoperability standard for utility applies primarily to claims with impossible limitations." CFMT, Inc. v. Yieldup International Corp., 349 F.3d 1333, 1339 (Fed. Cir. 2003); See, e.g., Process Control Corp. v. HydReclaim Corp., 190 F.3d 1350, 1359 (Fed. Cir. 1999) (claims found inoperable because they require violating the principle of conservation of mass); Newman v. Quigg, 877 F.2d 1575 (Fed. Cir. 1989) (claims to a perpetual motion machine ruled inoperable). Further, where the claims disclose several combinations, "the party asserting inoperability must show that all disclosed alternatives are inoperative or not enabled." CFMT, Inc. v. Yieldup International Corp., 349 F.3d at 1339 (Fed. Cir. 2003); EMI Group, 268 F.3d at 1349.

iii. Arguments

a. The Rejection

The Examiner's basis for rejecting claims 1-22 under 35 U.S.C. § 101 was an allegation that Appellants' claims lacked utility.

> Claim 1 is inoperative and therefore lacks utility.
>
> Claim 1 merely recited elements of an apparatus or a system without showing any functionality of an interrelationship among the recited elements and therefore is rendered inoperative lacking any utility. The recited elements of the system (simulated fleet configuration unit, reporting and analysis module and communication interface) do not impart any functionality or utility and as such the claimed invention is directed to non-statutory subject matter.

(See Office Action; Pages 3 and 4)

However, MPEP § 2105 requires that a rational basis must be present for any 35 U.S.C. § 101 rejection. In the first place, the Examiner should have made the § 101 rejection in the first office action in order to avoid delays in prosecution.[1] MPEP § 2106 (II). Thus, the Examiner's rejection is untimely. Further, the Examiner has the burden to establish a prima facie case that the invention does not produce a useful result.[2] Additionally, the Examiner has not shown how the language of the claims has been interpreted to support the rejection.[3] MPEP § 2106 (II)(A).

"When the examiner concludes that an application is describing an invention that is nonuseful, inoperative, or contradicts known scientific principles, the burden is on the examiner to provide a reasonable basis to support this conclusion. Rejections based on 35 U.S.C. 112, first paragraph and 35 U.S.C. 101 should be made." MPEP 2164.7 (I)(B). Further, the Examiner must provide evidence that one of ordinary skill "would reasonably doubt the asserted utility".[4] MPEP 2164.7 (I)(B); *In re Swartz,* 232 F.3d 862, 863, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000); *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995).

Additionally, rebuttal by Appellants is only necessary where there has been a proper § 101 rejection, including a corresponding 35 U.S.C. §112 rejection.[5] MPEP 2164.7 (I)(C); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The § 101 rejection is fatally flawed. Moreover, however, independent of the fatal flaws associate with the § 101

---

[1] "Office personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application." MPEP § 2106 (II).

[2] "Office personnel have the burden to establish a prima facie case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101. Compare Musgrave, 431 F.2d at 893, 167 USPQ at 289; In re Foster, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971)." MPEP § 2106 (II)(A).

[3] "[W]hen such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection." MPEP § 2106 (II)(A).

[4] "The examiner has the initial burden of challenging an asserted utility. Only after the examiner has provided evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence sufficient to convince one of ordinary skill in the art of the invention's asserted utility." MPEP 2164.7 (I)(B).

[5] "If a rejection under 35 U.S.C. 101 has been properly imposed, along with a corresponding rejection under 35 U.S.C. 112, first paragraph, the burden shifts to the applicant to rebut the *prima facie* showing." MPEP 2164.7 (I)(C).

rejection itself, there are no § 112 rejections. That is because the claims are fully supported under both Sections 101 and 112.

Nevertheless, in an effort to expedite prosecution, Appellants respond to the Examiner's alleged reasoning for inoperativeness and lack of interrelationship of the claim elements as a basis for the § 101 rejection.

Specifically, even though no prima facie showing has been made, Appellants traverse the rejection under MPEP 2107.2 (1).[6] See, e.g., *Raytheon v. Roper*, 724 F.2d 951, 958, 220 USPQ 592, 598 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 835 (1984) ("When a properly claimed invention meets at least one stated objective, utility under 35 U.S.C. 101 is clearly shown.").

b. Interrelationship Among the Recited Elements

The Examiner has apparently based the § 101 rejection, for all pending claims, on a supposed lack of operability in claim 1 due to a lack of interrelationship among the claim elements. Appellants submit that it is improper for the Examiner to reject all pending claims in the application based on a single independent claim. On general principles, at least the other independent claims and their respective dependent claims should be considered and given a proper basis for any rejection.

Appellants traverse the rejection of claim 1 under § 101 and demonstrate the interrelation of the claim elements. Although the Examiner has only particularly rejected claim 1, Appellants have considered each independent claim to rebut the Examiner's statement that claim 1 is without functionality due to a lack of interrelationship of the claim elements. Further, in an abundance of caution, representative additional utilities for the claimed invention are discussed in detail further below.

The reporting and analysis module of the second clause relates to the simulated fleet configuration unit of the first clause through a "parameter" that is introduced in the first clause. The communications interface of the third clause provides remote access to the system for a user that is introduced in the preamble. Thus, independent claim 1 is operative and does illustrate an

[6] "However, regardless of the category of invention that is claimed (e.g., product or process), an applicant need only make one credible assertion of specific utility for the claimed invention to satisfy 35 U.S.C. 101 and 35 U.S.C. 112; additional statements of utility, even if not "credible," do not render the claimed invention lacking in utility." MPEP 2107.02 (I).

interrelationship among the recited elements. Accordingly, the statement by the Examiner that the system lacks an interrelationship among the recited elements is rebutted.

Further, independent claim 16 is also independently interrelated. The second clause relates to the first clause at least through the "specific pieces" introduced in the first clause. The third clause relates to the second clause through the "market database" introduced in the second clause. The fourth clause relates to the second clause through the "parameter" introduced in the third clause. Finally, the fifth clause provides remote access for a user. Thus, the statement by the Examiner that the system lacks an interrelationship among the recited elements is rebutted.

Similarly, independent claim 19 also has interrelated elements. Clause (D) is related to: clause (A) through the "fleet database" that is introduced in clause (A); clause (B) through the "market database" that is introduced in clause (B); and the "pre-configured asset database" that is introduced in clause (C). Clause (E) is related to clause (D) through the "first piece" and "second piece" that are introduced in clause (D). Finally, clause (F) is related to clause (E) through the "report" that is introduced in clause (E).

In summary, Appellants have shown that the elements within each independent claim are interrelated.

c. Utility of the Claimed Invention

Although the Examiner has not met his initial burden, the specification clearly describes a number of utilities of the claimed invention. For example:

> "one aspect of the present invention, an electronic system for modeling a simulated fleet is provided. The capability to model a simulated or 'fantasy' fleet of assets provides the user with an effective and efficient mechanism to perform 'what if' analyses. The user can then use the results to evaluate what effect proposed changes to an existing fleet would have on overall fleet performance. The electronic system for modeling a simulated fleet includes a simulated fleet configuration unit, a reporting and analysis module, and a communications interface." (See Page 6, Lines 9-18).
>
> ***
>
> "The simulated fleet configuration unit is provided for allowing a user to add a plurality of assets to the simulated fleet. Each asset is defined as having at least one

parameter associated therewith. For example, in one embodiment, the parameter may be a total hourly cost to operate the asset. The reporting and analysis module is configured to generate a report having a composite output value that corresponds to the parameter and is characteristic of all of the assets in the simulated fleet. For example, the composite output value may be a composite total hourly cost for all the assets in the simulated fleet. Finally, the communications interface is configured to facilitate electronic remote access of the system by the user. For example, in a preferred embodiment, the communications interface allows access to the system over the Internet. This reduces the time and effort to obtain information. The system, according to this aspect of the present invention, provides a more effective asset management tool than available using conventional systems." (See Page 6, Lines 19-34; Page 7, Lines 1-2).

***

And, "[i]n a preferred embodiment, some of the assets contained in the simulated fleet correspond to assets already contained in the user's existing fleet. The remainder of the assets in the simulated fleet correspond to new or used assets proposed for acquisition by the user. The report generated by the reporting and analysis module contains a composite output value representative of all the assets in a simulated fleet, namely, both the existing assets, and the proposed assets to be acquired. The report may be compared to a second report generated based on the performance of the assets in the existing fleet alone. Comparison of the two reports by the user allows accurate evaluation of the impact of the proposed changes." (See Page 7, Lines 3-14).

Additionally, the prior art fails to address an important question of fleet managers: How does a change (e.g., an addition, or a subtraction) in the configuration of my fleet affect its overall performance? The known systems simply do not provide information as to how a combined fleet would perform. As stated explicitly in the specification: "Conventional asset management systems lack effective tools for conducting 'what if' analyses i.e., modeling a simulated fleet containing both actual assets and proposed assets. The invention overcomes the shortcomings inherent in conventional systems by providing an electronic system 20 for modeling a simulated fleet." (See Page 36, Lines 9-14).

For at least these utilities, Appellants submit that one skilled in the field of asset management and electronic commerce would not be skeptical of the benefits of the invention. Utilities of the invention include simulation, fleet modification efficacy determinations, optimization, cost reporting, and generally, fleet and asset management. These utilities are supported by the specification that provides advantageous teachings of the claimed invention. Thus, for one skilled in the art, there is utility for a system for modeling a simulated fleet that is more cost effective, less risky, and less time consuming than purchasing real assets to test an allocation theory. Therefore, the Examiner's statement regarding lack of utility is traversed.

B. Claims 1, 2, and 22 are Patentable Under 35 U.S.C. § 102(a).

a. Summary

Claims 1, 2, and 22 were rejected under 35 U.S.C. 102(a) as being anticipated by Pisula. Appellants respectfully traverse the rejection.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."[7] "The identical invention must be shown in as complete detail as is contained in the ... claim."[8] A rejection grounded on anticipation under 35 U.S.C. §102 is proper only where the subject matter claimed is identically disclosed or described in a reference. In other words, anticipation requires the presence of a single prior art reference which discloses each and every element of the claimed invention as arranged in the claim. However, Pisula does not disclose each and every element of Appellants' claimed invention as recited in Appellants' claims. Therefore, for the reasons set forth in detail below, claims 1, 2, and 22 patentably distinguish over Pisula, as well as the other references of record.

As the Examiner notes, Pisula "fails to teach the fleet (pool) and assets in the context of simulated assets and simulated fleet." (See Office Action; Page 5, Paragraph 12). Further, claims 1, 2, and 22 include limitations related to simulation. Inasmuch as the limitation is required by the plain language of the claims, it is unclear how Pisula, lacking the "simulated assets," reads upon the claims or how the Examiner is relieved of the obligation to cite prior art reading upon the limitation. Claims 1, 2, and 22 are each separately patentable for at least this reason. Thus, the Examiner's § 102 rejection must be reversed.

b. Claim 1

Claim 1 was rejected by the Examiner as being anticipated by Pisula. Appellants respectfully disagree. Claim 1 requires "a simulated fleet configuration unit configured to allow a user to add one or more assets to said simulated fleet." Contrarily, Pisula relates to *real assets*

[7] *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).
[8] *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

and provides "a system and method [for] accessing freight transportation network information over the internet." (See Pisula; Page 2, Lines 11-12). Similarly, Pisula states its field as relating "generally to systems and methods for accessing information over the internet, and more particularly for graphically organizing freight transportation network information on a map over the internet." (See Pisula; Page 1, Lines 13-15). Further, Pisula solves problems related to tracking of *real assets* wherein "many of the major transportation industries provide various traditional methods by which a customer may obtain the current status of their shipments." (See Pisula; Page 2, Lines 20-21). Thus, the discussion of background art clearly defines the problems that Pisula solves as providing information related to *real assets*, rather than simulated assets. (See Pisula; Page 2, Lines 1-6).

The Examiner refers to FIGS. 4 and 5 as examples relating to "a simulated fleet configuration unit" as required by claim 1. (See Office Action; Page 4, Numbered Paragraph 8). However, Pisula does not teach that FIGS. 4 and 5, or any figures, relate to a "simulated fleet." (See Pisula; FIGS. 4 and 5). Indeed, Pisula teaches away from a simulated fleet concept in that the reference recites applications for *actual fleets*. For example, "[a] fleet Updating feature provides the user with an ability to add and/or delete equipment from their pools." (See Pisula; Page 6, Lines 9-11). Although the Examiner may have noticed the words "Test Pool" and "test fleet" on the face of FIGS. 4 and 5, the word "test" does not, in and of itself, teach or suggest a "simulated fleet." (See Pisula; FIGS. 4, 5). On the contrary, the word "test" is indicative of a setup procedure to validate whether or not the system works. Confirmation of the "real" nature of Pisula's application is found in the specification with respect to exemplary diagram FIG. 4. The information contained in FIG. 4 relates to real assets where a "user can view, print and export Electronic Data Interchange reports, such as weight messages, inventory reports, arrival notices, and standing orders." (See Pisula; Page 6, Lines 4-11). When read in context with the field, background, and summary of Pisula, it is clear that FIG. 4 relates to real assets. (See Pisula; Page 1, Lines 12-26; Page 2, Lines 1-28);

Accordingly, Pisula teaches a system for managing fleets of *real assets*. Thus, Pisula does not disclose a "simulated fleet." Claim 1 is therefore patentable over the Pisula reference and in condition for allowance.

c. Claim 2

Claim 2 was rejected by the Examiner as being anticipated by Pisula. Appellants respectfully disagree. Claim 2 depends from claim 1. For at least the same reasons as claim 1, dependent claim 2 is in condition for allowance. Additionally, the Examiner has not addressed the remaining elements of claim 2 that include:

> "a fleet search module including a first add-to-fleet feature;
> a simulated fleet module including an add-asset feature, and
> a market search module including a second add-to-fleet feature."

Each of these limitations found in claim 2 are not addressed by the Examiner and are not found in the Pisula reference. Thus, claim 2 is independently patentable over Pisula.

d. Claim 22

Although the Examiner has rejected claim 22 under 35 U.S.C. § 102(a) as being anticipated by Pisula, claim 22 has not been addressed by the Examiner in a § 102 rejection. Thus, the Examiner's specific positions with respect to Pisula and numerous specific claimed features remain unclear. As a result, Appellants respectfully request that if the Examiner were to maintain the rejection in light of the arguments in this response, that additional clarity be provided to assist in understanding the Examiner's position.

Nevertheless, Pisula has been carefully considered and the claimed invention is substantially different from the teachings of Pisula. Significantly, Pisula relates to *real assets* and provides "a system and method [for] accessing freight transportation network information over the internet." (See Page 2, Lines 11-12). Clearly, the assets discussed in Pisula are not simulated. Claim 22 requires "a simulated fleet configuration unit configured to allow a user to add one or more simulated assets to said simulated fleet". As argued above with respect to claim 1, Pisula does not contemplate the use of simulated assets. Further, Pisula does not disclose the use of both simulated and pre-existing fleet assets with a simulated fleet configurator. Thus, claim 22 is patentably distinct.

C. Claim 22 is Patentable Under 35 U.S.C. § 103(a).

a. The Law

MPEP § 2143 sets forth the basic requirements for the Patent and Trademark Office to establish prima facia obviousness as follows: "To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143. A case of obviousness requires that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP § 2143; *In re Linter,* 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills,* 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), *W.L. Gore and Associates, Inc. v. Garlock, Inc.* 220 USPQ 303 (Fed. Cir., 1966). Moreover, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood,* 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Independently of the cited prior art's lack of teaching of claim elements in each of the independent claims, Applicants respectfully traverse the 103(a) rejection because there are no suggestions, motivations, or objective reasons to combine the cited reference with the knowledge of ordinary skill in the art to form "a simulated fleet in accordance with the instant claim." (See Office Action Page 6). "If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue." *In re Rouffet*, 47 USPQ2d 1453 at 1457 (Fed Cir. 1998). "Rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability'."

Id. quoting *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

In re Oetiker further provides that "[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). "The Examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 47 USPQ2d 1453, at 1458 (Fed. Cir. 1998) (emphasis added).

As established by Federal Circuit precedent, to establish a *prima facie* case of obviousness, the Examiner must provide some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. *See, e.g., Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) ("To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references"); *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"); *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) ("Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination"); *accord.* MPEP § 2143.

It is established law that one "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Ecolochem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 1371, 56 USPQ2d 1065 (Fed. Cir. 2000) (citing *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988)). Indeed, "[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Moreover, "[t]he mere fact that references can be combined or modified does not

render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Appellants respectfully submit that it is inappropriate to assert only a single reference along with the Examiner's belief that "it would have been obvious to one of ordinary skill ... to have a system of modeling a simulated fleet." (See Office Action, Page 6). Pisula does not suggest, teach, or provide a motivation to modify the teachings to include a simulated fleet as claim 22 requires. In fact, the Examiner has not provided a motivation, but rather simply a statement that it would have been obvious. Such a statement by the Examiner falls short of a convincing argument to make the leap from a simulated fleet to the teachings of Pisula's uses for real assets.

b. Arguments

Appellants note that the remarks presented above with respect to § 102 are equally applicable here. Claim 22 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Pisula. Appellants respectfully traverse the rejection.

i. The Elements of Claim 22 are not Present in Pisula

As amended, claim 22 requires "a simulated fleet configuration unit configured to allow a user to add one or more simulated assets to said simulated fleet, each of pre-existent and simulated asset having a parameter associated therewith," that is not disclosed in Pisula. As discussed above with respect to claim 1, Pisula does not disclose "a simulated fleet configuration unit" because Pisula does not teach or disclose simulated assets. Indeed, Pisula teaches away from the simulated fleet configuration unit by not disclosing the teachings in the context of simulated assets and simulated fleets, as was noted by the Examiner. (See Office Action Page 5, Paragraph 12). Thus, it is clear that Pisula did not contemplate configurations including a simulated asset and a simulated fleet.

Further, claim 22 requires "a reporting and analysis module configured to generate a report having a composite output that corresponds to said parameter and is characteristic of all of said assets in said simulated fleet," that Pisula does not disclose. The Examiner has not particularly pointed to the "reporting and analysis module" as is required by claim 22 but notes

the "inventory reports" of Pisula. (See Page 6, Line 8). Rather, Pisula discloses a system for "graphically organizing freight transportation network information on a map." (See Page 1, Lines 13-15). The Pisula system is tailored for plotting real assets to a geographic map as is discussed above with respect to claim 1. Thus, the "inventory reports" are directed to real assets for real fleets, rather than for a simulated fleet.

In summary, Pisula does not disclose the necessary claim elements. Further, as the Examiner notes, Pisula "fails to teach the fleet (pool) and assets in the context of simulated assets and simulated fleet." (See Office Action Page 5, Paragraph 12). Thus, claim 22 is in condition for allowance.

ii. There is No Motivation to Modify Pisula

The Examiner states that "it would have been obvious to one of ordinary skill ... to have a system of modeling a simulated fleet." (See Office Action, Page 6). Notably, no suggestion or motivation exists in the Pisula reference itself. Thus, the suggestion or motivation must have come from the Examiner. However, the Examiner has only made the statement that it would have been obvious "to have a system of modeling a simulated fleet." Such a statement alone does not constitute a convincing line of reasoning as to why a person of ordinary skill in the art would have found the limitations of claim 22 obvious from the teachings of Pisula. Accordingly, the § 103 rejection of claim 22 should be reversed.

iii. There is No Reasonable Likelihood of Success

Both the prior art of record and the Examiner's statements lack any motivation or suggestion that the teachings of Pisula could be employed with a "simulated fleet" and a "simulated asset." Indeed, as is also discussed above with respect to claim 1, Pisula teaches directly away from the claimed invention. That is to say, Pisula claims a field that is related to *real assets*, teaches a problem solution for *real assets*, and describes embodiments of the solution in terms of *real assets*. (See Pisula; Page 1, Lines 12-16; Page 2, Lines 1-28). At no time does Pisula suggest using the teachings with a "simulated fleet" and a "simulated asset."

Further, the Examiner has failed to state any motivation other than his own to cast Pisula in light of using a "simulated fleet" and a "simulated asset." Nor has the Examiner demonstrated

that attempting such a combination would have had a reasonable expectation of success. Perhaps more importantly as explained above, Pisula teaches a system for tracking real assets and does not describe a simulation system. Thus, Pisula does not teach or suggest a "simulated fleet" and a "simulated asset." Without even the mere suggestion of using the teachings of Pisula for simulation and without any discussion related to such a teaching, Pisula is incapable of success for practicing the claimed invention.

Accordingly, for at least these independent reasons, the § 103 rejection of claim 22 is improper.

VII. CONCLUSION

In view of the foregoing arguments, Appellants respectfully submit that the pending claims are patentable under 35 U.S.C. § 101, and are further novel over the cited reference and therefore, are patentable under 35 U.S.C. § 102(a) and 35 U.S.C. § 103(a). The Examiner's rejection of claims 1-22 is improper because the prior art of record does not teach or suggest each and every element of the claimed invention. In view of the above analysis, a reversal of the rejections of record is respectfully requested of this Honorable Board.

Appellants believe no fee is due with this paper. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 65678-0004, from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged to the above account.

Respectfully submitted,

Date: October 21 , 2005

By: _____

Michael B. Stewart, Reg. No. 36,018
Charles A. Bieneman, Reg. No. 51,472
Rader Fishman and Grauer PLLC
39533 Woodward Ave, Suite 140
Bloomfield Hills, Michigan 48304
Attorneys for Appellants

Customer No. 0102091

Telephone Number (248) 594-0600

APPENDIX A – CLAIMS ON APPEAL

A complete listing of the claims that are the subject of this Appeal is as follows.

1. (Original) An electronic system for modeling a simulated fleet comprising:

a simulated fleet configuration unit configured to allow a user to add one or more assets to said simulated fleet, each asset having a parameter associated therewith;

a reporting and analysis module configured to generate a report having a composite output that corresponds to said parameter and is characteristic of all of said assets in said simulated fleet; and

a communications interface configured to facilitate electronic remote access of said system by the user.

2. (Original) The system of claim 1 wherein said simulated fleet configuration unit comprises one of:

a fleet builder module, including a step-by-step asset entry system;
a fleet search module including a first add-to-fleet feature;
a simulated fleet module including an add-asset feature, and
a market search module including a second add-to-fleet feature.

3. (Original) The system of claim 1 wherein said simulated fleet configuration unit is further configured to store data associated with said assets of said simulated fleet in a first database, said first database further including data associated with assets in an existing fleet, said simulated fleet configuration unit being further configured to allow the user to add assets from said existing fleet to said simulated fleet.

4. (Original) The system of claim 3 wherein said simulated fleet configuration unit is configured to execute on an application server.

5. (Original) The system of claim 3 further including a second database that includes data associated with assets available for one of a purchase, rental and lease transaction, wherein said simulated fleet configuration unit is further configured to allow the user to add one or more assets from said second database to said simulated fleet.

6. (Original) The system of claim 5 further including a third database that includes data associated with a plurality of pre-configured assets, each preconfigured asset comprising a parameter having a composite value derived from corresponding parameter values associated with a plurality of specific assets of a similar type, said simulated fleet configuration unit being further configured to allow the user to add one or more assets based on type from said third database to said simulated fleet.

7. (Original) The system of claim 6 wherein said simulated fleet includes a first asset from said existing fleet, and a second asset selected from one of said second database corresponding to assets for purchase, rental and lease, said third database corresponding to pre-configured assets, and user-defined assets.

8. (Original) The system of claim 3 wherein said assets comprise industrial equipment.

9. (Original) The system of claim 8 wherein said assets comprise forklifts.

10. (Original) The system of claim 9 wherein said parameter includes at least one of a total maintenance cost, an hourly maintenance cost, a total lease cost, a total operating cost, a total hourly operating cost, and a utilization rating.

11. (Original) The system of claim 10 wherein said parameter is one of said total maintenance cost, said total lease cost, and said total operating cost, and wherein said reporting and analyzing module is further configured to determine said composite output according to an arithmetic sum function.

12. (Original) The system of claim 10 wherein said parameter is one of said hourly maintenance cost, said total hourly cost, and said utilization, wherein said reporting and analyzing module is further configured to determine said composite output according to an arithmetic average function.

13. (Original) Th e system of claim 7 wherein said report associated with said simulated fleet is a first report, said reporting and analyzing module being further configured to generate a second report having another composite output that is associated with said existing fleet, to thereby allow the user to compare said first and second reports to evaluate the existing fleet and the simulated fleet.

14. (Original) The system of claim 3 wherein said reporting and analyzing module is configured to execute on an application server.

15. (Original) The system of claim 3 wherein said communications interface comprises a Hyper-Text Transfer Protocol (HTTP) compliant web server.

16. (Original) An electronic s ystem for modeling a simulated fleet comprising:

a fleet database including data associated with an existing fleet comprising a plurality of specific pieces of industrial equipment;

a market database including data associated with a plurality of specific pieces of industrial equipment that are available for one of purchase, rental and lease;

a simulated fleet configuration unit configured to allow a user to add a first piece of industrial equipment to said simulated fleet from said existing fleet based on data in said fleet database, said simulated fleet configuration unit being further configured to allow said user to add a second piece of industrial equipment based on data from one of said market database, and user-defined industrial equipment, each piece of industrial equipment having a parameter associated therewith;

a reporting and analysis module configured to generate a report having a composite output corresponding to said parameter that is characteristic of all pieces of industrial equipment in said simulated fleet; and

a communications interface configured to facilitate electronic remote access by said user.

17. (Original) The system of claim 16 further including a pre-configured asset database that includes data associated with a plurality of modeled pieces of industrial equipment based on type.

18. (Original) The system of claim 17 wherein said report is a first report, said reporting and analysis module being further configured to generate a second report having another composite output based on industrial equipment in said existing fleet to thereby allow the user to compare said first and second reports to evaluate said existing and simulated fleets.

19. (Original) A method of modeling a simulated fleet comprising the steps of:

(A) providing a fleet database including data associated with an existing fleet comprising a plurality of specific pieces of industrial equipment;

(B) providing a market database including data associated with a plurality of specific pieces of industrial equipment that are available for one of purchase, rental and lease;

(C) providing a pre-configured asset database that includes data associated with a plurality of modeled pieces of industrial equipment based on type;

(D) selecting a first piece of industrial equipment for inclusion in said simulated fleet from the existing fleet based on data in the fleet database, and further selecting a second piece of equipment based on data from one of the market database, the pre-configured asset database and user-defined pieces of industrial equipment, each piece of industrial equipment having a parameter of interest associated therewith;

(E) generating a report having a composite output value as a function of respective parameter values associated with the first and second pieces of equipment; and

(F) electronically transmitting the report to the user at a remote location.

20. (Original) The method of claim 19 wherein the report is a first report, said method further including the step of:

generating a second report having another composite output value based on respective parameter values associated with pieces of industrial equipment in the existing fleet to thereby allow the user to compare the first and second reports to evaluate the existing and simulated fleets.

21. (Original) The method of claim 20 wherein the parameter comprises a financial figure.

22. (Previously Presented) An electronic system for modeling a simulated fleet comprising a combination of pre-existing fleet assets and simulated assets comprising:

a simulated fleet configuration unit configured to allow a user to add one or more simulated assets to said simulated fleet, each of pre-existent and simulated asset having a parameter associated therewith;

a reporting and analysis module configured to generate a report having a composite output that corresponds to said parameter and is characteristic of all of said assets in said simulated fleet; and

a communications interface configured to facilitate electronic remote access of said system by the user.

APPENDIX B – EVIDENCE APPENDIX

In this Appeal, Appellants do not rely on any evidence submitted pursuant to 37 C.F.R §§ 1.130, 1.131, or 1.132, or on any other evidence entered by the Examiner.

APPENDIX C – THIS BOARD'S DECISION IN RELATED CASE 09/441,289

Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW E. SUHY and BRENT C. PARENT

Appeal No. 2004-1971
Application No. 09/441,289

ON BRIEF

Before BARRETT, BARRY, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 16 and 21-48, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to an apparatus and method for tracking physical assets. An understanding of the invention can be derived from a reading of exemplary claim 16, which is reproduced as follows:

16. A method for automatically gathering and analyzing data without human intervention relating to an asset comprising the steps of:

(a) generating a maintenance invoice from an analysis controller when service is performed on the asset, wherein the maintenance invoice includes an indication of the amount of usage of the asset, wherein said indication of the amount of usage is captured by a data acquisition device, and wherein a receiver receives the indication of the amount of usage from the data acquisition device through a transmitter;

(g) transmitting the maintenance invoice on a communication network from the analysis controller to an administrative controller;

(h) comparing on the analysis controller, the indication of the amount of usage of the asset with a predetermined standard that is representative of the warranty period; and

(I) generating a warranty report from said administrative controller without said human intervention if the amount of usage is less than the predetermined standard.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

McGuire et al. (McGuire)	4,404,639	Sep. 13, 1983
Nguyen et al. (Nguyen)	6,003,808	Dec. 21, 1999 (filed Jul. 11, 1997)
Barzilai et al. (Barzilai)	6,012,045	Jan. 4, 2000 (filed Jul. 1, 1997)
Yamamoto et al. (Yamamoto)	6,141,629	Oct. 31, 2000 (filed Jul. 13, 1998)

Sager, Business Week, "The Great Equalizer," wysiwyg://19/htp://-www.businessweek.com/1998/35/z3372007/htm (May 18, 1994)

Deierlein, Beverage World, "New Lease on truck life: Automated Maintenance" ISSN: 0098-2318, v113n1566, pp. 138 (May 1994)

Claims 16 and 43-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of Deierlein, Sager, Nguyen and McGuire.

Claims 25-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of Barzilai, Nguyen and McGuire.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 34, mailed December 12, 2003) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (Paper No. 33, filed September 11, 2003) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered.

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise,

reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer. Upon consideration of the record before us, we reverse.

We begin with the rejection of claims 16 and 43-48 under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of Deierlein, Sager, Nguyen and McGuire. We turn first to claim 16. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins &

Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

From our review of the entire record, we note at the outset that the invoice of claim 16 does not have to be written on paper. Rather, the invoice can be displayed on a monitor. From the disclosure of Yamamoto, we find that the computer 21, which displays maintenance information such as the remaining hours until maintenance is due, is a disclosure of generating (on the monitor's display) a maintenance invoice from an analysis controller (computer 21). From the disclosure (col. 11, lines

17-23) that a determination is ordinarily made as to whether or not the user has performed maintenance, such as an overhaul or replacing consumable parts, the data is input into the computer 21, we find that the maintenance "invoice" is displayed on computer 21 when service is performed on the asset. In addition, in Yamamoto, an invoice of information regarding when maintenance is due is displayed on computer 21 when the information is sent to computer 21 by managing computer 51. In addition, as noted by appellants (brief, page 16), Yamamoto is directed to determining when maintenance should be performed, and is not directed to generating a warranty report.

From the teachings of Deierlein of accessing the truck's maintenance history, determining necessary repairs and automatically informing the technician if a repair is covered by warranty, and if so directly billing the supplier for the repair or replacement, we find that Deierlein discloses both determining needed maintenance, as well as whether the repair is covered under a product warranty, and notifying the supplier. In addition, from the disclosure of Nguyen of receiving fault codes and developing a maintenance action log and removal records, as well as a warranty report generator, we find that Nguyen also discloses determining necessary repairs and determining if a

repair is covered under a product warranty, and generating a warranty report. Because Yamamoto is directed to determining when maintenance needs to be performed, we find that an artisan, in view of the teachings of Deierlein and Nguyen, would have been motivated to provide the maintenance time determining system of Yamamoto with a system for additionally determining if a needed repair is covered by a warranty, so that the company can be repaid for the cost of the repairs. However, upon providing Yamamoto with a warranty determination system, we find that the system would be added to managing computer of network 50 of Yamamoto (see figure 12) because network 50 manages and controls the maintenance information (col. 9, lines 5-17) and updates the remaining life of the machines. We find no evidence that an artisan would have been motivated to provide the warranty determination system of Nguyen to computer 21 at monitoring station 20 of worksite 30, because computer 21 is the display location where the user inputs into the system the information as to maintenance that has been performed (col. 11, lines 17-23). Since network 50 is where the maintenance information is managed and controlled, we find that an artisan would have been motivated to add the warranty determination system at managing computer 51 of network 50. However, claim 16 recites that the analysis

controller compares the amount of usage with a predetermined standard representative of the warranty period. As the examiner relies upon elements 20 and 21 of Yamamoto as the analysis controller (answer, pages 9 and 10), we find that even if the prior art were combined as suggested by the examiner, the resultant structure would not meet all of the limitations of the claim as the comparing of usage with warranty terms would be carried out by managing computer 51 of network 50, and not by computer 21 at worksite 30. Accordingly, the rejection of claim 16, and claims 43-48, dependent therefrom, is reversed.

We turn next to the rejection of claims 21-42 under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of Barzilai, Nguyen and McGuire. The examiner acknowledges (answer, page 7) that Yamamoto does not teach, inter alia, automatic determination of whether or not maintenance has been performed at the analysis controller. The examiner asserts (id.) that it would have been obvious to one of ordinary skill to allow the analysis controller to perform such a function.

From our review of Yamamoto, we find that Yamamoto discloses (col. 8, line 62 through col. 9, line 4) that:

> A computer **21** having functions for coordinating the control of the vehicles within the work site **30** is installed in the monitoring station **20**. This computer

> 21 comprises an input device for inputting information pertaining to maintenance (in-house maintenance) performed by the user in the work site **30** as will be described below, and a display device for displaying, to the user in the work site **30**, maintenance information such as the remaining life until maintenance due time (remaining hours) for each of the plurality of vehicles **10**, **11**, ..., at the work site **30**.

From this disclosure of Yamamoto, we find that at computer 21, which the examiner considers to be the claimed analysis controller, information pertaining to maintenance information performed by the user is input by the user. Because the maintenance information is input by the user, we agree with the examiner that Yamamoto does not teach that the analysis controller makes an automatic determination of whether or not maintenance has been performed. Claim 21 recites that "said analysis controller being configured for automatically determining without human intervention whether maintenance of the asset has been provided."

We are not persuaded by the examiner's assertion (answer, page 7) that "[i]t would have been obvious to one of ordinary skill to allow the analysis controller to support such a function" because the analysis controller is linked to the administrative controller. The fact that the computer 21

(analysis controller) and the network 50 (administrative controller) communicate back and forth with each other (col. 9, lines 24-30) is not a teaching of changing input by a user into an automatic determination without human intervention, as required by independent claim 21.

On pages 14 and 15 of the answer, the examiner takes the position that with respect to claim 21, the examiner considers network 50 to be the analysis controller. Irrespective of whether the examiner considers computer 21 or network 50 (having managing computer 51) to be the claimed analysis controller, the fact that the maintenance information is inputted by the user into computer 21 or computer 55 (described, supra) and then transmitted to network 50, does not teach or suggest that the input of information by the user results in the maintenance information being automatically determined, without human intervention, due to the configuration of the analysis controller.

We note the disclosure of Yamamoto (col. 12, line 63 through col. 13, line 3) that when an engine is overhauled at a maintenance plant information to this effect is input by an input device to computer 55 at the maintenance plant, and then input to managing computer 51 via global network 50. From this disclosure

of Yamamoto, we find that input maintenance performed can be input to computer 21 or to computer 55 and then input to managing computer 51. Thus, we find that managing computer 51 does not make an automatic determination, without human input, of maintenance provided. Accordingly, neither computer 21 of monitoring station 20 nor managing computer of network 50 automatically determines, without human intervention, whether maintenance to the asset has been provided. The other references do not make up for this feature missing from Yamamoto. Accordingly, even if we combined the prior art as asserted by the examiner, the resultant combination would not meet all of the limitations of claim 21. Accordingly, we find that the examiner has failed to establish a prima facie case of obviousness of independent claim 21. The rejection of claim 21, and claims 22-30, dependent therefrom, under 35 U.S.C. § 103(a) is therefore reversed.

We turn next to independent claim 31. We reverse the rejection of claim 31 because claim 31 recites, identically to claim 21, that "said analysis controller being configured for automatically determining without human intervention whether maintenance of the asset has been provided." Accordingly, the

rejection of claim 31, and claims 32-37, dependent therefrom, is reversed.

We turn next to the rejection of claims 38-42. We observe at the outset that appellants do not provide any separate arguments for independent claim 38, and groups claim 38, inter alia, with independent claim 21. In contrast to independent claim 21, which recited that the analysis controller is configured for automatically determining without human intervention whether maintenance of an asset has been performed, claim 38 does not recite that the determination is automatic, or that the determination is done without human intervention. We note the disclosure of Yamamoto (col. 11, lines 17-19) that "[n]ext, a determination is ordinarily made as to whether or not the user has performed maintenance (in-house maintenance)." Yamamoto discloses that after the maintenance information is input, an addition point associated with the type of maintenance is added to the current score of the component (col. 11, lines 24-28). Although this determination is not automatic or done without human input, it is a determination made as a result of the configuration of computer 21. In addition, we find that as shown in figure 12 of Yamamoto, that assets 11, 12, and 13 do not necessarily communicate directly with monitoring station 10, but

rather can communicate through assets 10 and 13. In order to communicate with monitoring station 20 through assets 10 and 13, these assets will inherently contain a controller, to the extent that the controller has been broadly set forth in claim 38. In addition, we note that claim 38 does not recite a comparison related to a predetermined standard representative of a warranty period or the generation of a warranty report as recited in independent claim 16. We are not persuaded by appellants assertion (brief, page 17) that:

> the claims of Claim Group B are not obvious because the cited references do not teach all of the claim limitations of Claim Group B. Omissions in the cited art that are discussed below include: (I) an analysis controller located at a second location remote from said local controller; (ii) a data acquisition device to [sic, for] sensing at least one operating characteristic; and (iii) transmitting acquired data from the acquisition device through space to said receiver.

Local controllers 10 and 13 transmit over space to monitoring station 10 which transmits over space "J" to managing and control network 50, including managing computer 51. In addition, assets 11 and 12 have data acquisition devices which transmit information to monitoring station 20 via local controllers 10 and 13. Moreover, controllers 10 and 13 transmit data acquired from acquisition devices on asserts 11 and 12 to monitoring station

20, which transmits the information to network 50. We are not persuaded by appellants' assertion (brief, page 20) that no cited reference discloses an administrative controller separate from said analysis controller because claim 38, unlike independent claim 16, does not recite an administrative controller separate from the analysis controller.

Nor are we persuaded by appellants' assertion that there is no motivation for combining the references. We make reference to our findings, supra, for combining the teachings of Yamamoto and Nguyen. In addition, although claim 38 does not recite the term "warranty," the claim refers to responsible parties which we construe to mean manufacturers whose product(s) are covered by warranties. Upon providing Yamamoto with the warranty determination system of Nguyen, the managing computer 51 would be able to determine if a needed repair was covered by a warranty, and if so, which manufacturer was responsible for the cost of the warranty repair/replacement of an asset or part of an asset. However, although computer 21 may be considered to provide a determination of whether maintenance has been provided (Yamamoto col. 11, lines 17-19) managing computer 51 is not disclosed as making a determination of whether maintenance has been provided. Upon combining the teachings of Yamamoto and Nguyen, the result

would be that the warranty determination system of Nguyen would be provided in the managing computer 51 of network 50. However, claim 38 requires that the analysis controller, in addition to determining whether maintenance of an asset has been provided, also automatically determines which responsible party is responsible for the maintenance performed. Since managing computer 51 would be automatically determining the responsible party, and computer 21 would be determining if maintenance has been provided, the two computers, on separate networks, cannot be considered to be the same analysis controller. The examiner relies upon Barzilai for a disclosure of collation of data to obtain warranty data, and particularly for a teaching of the company who will fulfill and correct the warranty problem. In addition, the examiner relies upon McGuire for a disclosure of automated invoicing.

With respect to Barzilai, we find the reference to be cumulative of the disclosure of Nguyen who discloses a warranty determination system, including the generation of warranty reports, and does not overcome the basic deficiencies of Yamamoto and Nguyen. In addition, as claim 38 does not recite invoicing, we find McGuire to be cumulative to the teachings of Yamamoto, Nguyen and Barzilai. From all of the above, we find that the

prior art fails to suggest all of the limitations of independent claim 38. Accordingly, the rejection of claim 38 under 35 U.S.C. § 103(a), and claims 39-42 which depend therefrom, is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 16 and 25-48 under 35 U.S.C. § 103(a) is reversed.

REVERSED

LEE E. BARRETT
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

STUART S. LEVY
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

SSL/cam

RADAR, FISHMAN & GRAUER, PLLC
39533 Woodward Avenue
Suite 140
Bloomfield Hills, MI 48304-0610

APPENDIX D – THIS BOARD'S DECISION IN RELATED CASE 09/653,735

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW F. SUHY, JR.

Appeal No. 2005-0013
Application No. 09/653,735

ON BRIEF

Before BARRETT, BARRY, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-8 and 12-24, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to an apparatus and method for tracking and managing physical assets. An understanding of the

invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. A system for gathering and analyzing data relating to a non-fixed movable asset comprising:

a local controller located at a first location for acquiring data that is representative of at least one operating characteristic of the asset;

an analysis controller located at a second location that is responsive to said acquired data from said local controller for generating an analysis of said acquired data; and

an electronic communications network connected between said local controller and said analysis controller and permitting transmission of said acquired data from said local controller to said analysis controller; and

a sub-system that analyzes said at least one operating characteristic of the asset to determine a lease rate for the asset, the lease rate being a variable.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Koether	5,875,430	Feb. 23, 1999
Nguyen et al. (Nguyen)	6,003,808	Dec. 21, 1999 (Jul. 11, 1997)
Albertshofer	6,230,081	May 8, 2001 (Aug. 7, 1998)

Claims 1-7 and 12-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Koether in view of Albertshofer.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Koether in view of Albertshofer and Nguyen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 16, mailed May 17, 2004) for the examiner's complete reasoning in support of the rejections, and to appellant's brief (Paper No. 15, filed February 17, 2004) and reply brief (Paper No. 17, filed July 19, 2004) for appellant's arguments thereagainst. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we reverse, essentially for the reasons set forth by appellant. We begin with the rejection of claims 1-7 and 12-24 under 35 U.S.C. § 103(a) as being unpatentable over Koether in view of Albertshofer. We turn first to independent claims 1, 13 and 18.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings

by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, pages 5 and 6) is that Koether does not explicitly recite determining a lease rate. To overcome this deficiency of Koether, the examiner turns to Albertshofer for a teaching of an asset usage monitoring system that monitors asset performance over time for determining a lease rate. In addition, the examiner (id.) relies upon Webster's Ninth College Dictionary for a definition of "rate" which is defined as "'a quantity, amount, or degree of something measured per unit of something else'." The examiner asserts (id.) that it would have been obvious to calculate a rate based on any quantity, amount or degree of something within the scope of knowledge and understanding of an artisan, such as owners of

equipment who also maintain the equipment that they lease to others. The examiner adds that it would have been obvious to combine the systems of Koether and Albertshofer in order to accurately determine fees for the rental and leasing of capital equipment.

The examiner additionally asserts (answer, page 9) that appellant has not made clear how "rate" is defined beyond the lease rate being a variable, and that in Albertshofer the lease rate is a variable as it is based on usage. It is further argued (id.) that appellant's specification does not support as specific a definition of rate as set forth in the brief.

Appellant asserts (brief, page 9) that the prior art does not teach or suggest the claim limitation of an analysis of "at least one operating characteristic of the asset to determine a lease rate for the asset," because the prior art doesn't teach determining a lease rate as recited in claims 1, 13 and 18. It is further argued (brief, page 10) that Albertshofer teaches calculating a total lease amount based on usage duration of the vehicle or the distance it has gone, and that Albertshofer's rate is a constant independent of an operating characteristic. It is argued that Albertshofer does not teach determining a lease rate for an asset, much less determining a lease rate based on an

analysis of an operating characteristic of the assert. Appellant asserts that Albertshofer's disclosure is directed toward one-time usage of a golf cart, and that if a user rents the cart at an hourly rate of $10, then renting it for two hours results in a total lease amount of $20. Appellant adds that Albertshofer's rate is a constant multiplied by the variable operating characteristic, which is a usage duration, e.g., $10 per hour. It is further asserted (id.) that in appellant's invention, the rate is a variable affected by an analysis of at least on operating characteristic. Appellant states (brief, page 11) that "Albertshofer does not teach determining a lease rate that can then be used as a variable in the calculation of the amount to be charged for a lease."

Appellant further asserts (brief, page 12) that there is no motivation to combine the teachings of Koether and Albertshofer. It is argued that "[t]he examiner provides no explanantion as to why one of ordinary skill in the art would have been motivated by the cited references *to analyze an operating characteristic of an asset to determine a lease rate for the asset*. Moreover, the cited references provide no motivation for their combination." Furthermore, with regard to claim 18, appellant adds (id.) that neither reference discloses the claim limitation of "maintenance

information affecting said lease rate." It is argued (brief, page 13) that although Albertshofer discloses using service manuals to assist in automating vehicle maintenance, Albertshofer does not teach using maintenance information to determine a lease rate.

Upon careful review of Koether, we find the reference to be silent as to leasing of the disclosed kitchen appliances, and the examiner has failed to point to any suggestion in the reference that the kitchen appliances can be leased. Because Koether is completely silent as to leasing of the kitchen appliances, we find no teaching or suggestion to combine the teachings of Koether and Albertshofer as advanced by the examiner. However, we find Albertshofer to be closer to the claimed invention than the examiner recognized. Considering Albertshofer alone, we find that Albertshofer discloses an information system for displaying data on a golf cart (col. 1, lines 5-7). Albertshofer discloses that it is known to lease electric or engine-powered equipment in order to save on investment costs (col. 4, lines 9-12). Accounting for such services is generally done in a time-dependent fashion, or can be duty-dependent as a function of duration and intensity of use (col. 4, lines 12-15). It is

disclosed that if the duty-hour counter or distance-gone counter is tampered with, the result may be that the true wear and tear of the equipment exceeds the level as calculated by the leasing company on the basis of the information received (col. 4, lines 16-23). From the disclosure that accounting services are based on time dependency, or duration and intensity of use, and the disclosure suggesting that leases are calculated based on estimated wear and tear of the product, we find that Albertshofer teaches the determination of a lease rate by the leasing company, that is based upon operating characteristics.

In addition, from the disclosure of wirelessly transmitting collected data from the power equipment to the base station, we find teachings of a local controller on the power equipment, an analysis controller in the form of the base station, and an electronic communications network in the form of wireless communications between the power unit (golf cart) and the base station (col. 3, lines 40-43). Albertshofer additionally discloses (col. 5, lines 23-26) that "[v]ehicles, machines and equipment of all kinds, be they electrically powered, engine powered or peneumatically/hydraulically powered, as well as lifting platforms and, for instance, golf carts are suitable as

such equipment items." From the disclosure that the system can be used with a hydraulically-powered lifting platform, we find that Albertshofer suggests using the system with a forklift, as disclosed by appellant.

However, although Albertshofer teaches or suggests determining a lease rate, we find no suggestion of a sub-system in Albertshofer for carrying out the determination of the lease rate. We presume that the information gathered by the base station is somehow used by the leasing company, through their accounting methods, to determine the lease rate. However, no sub-system is disclosed for analyzing the collected data from the golf cart or other equipment and using this analyzed data in determining the lease rate. Accordingly, we find that Albertshofer alone is not sufficient to teach or suggest appellant's independent claims 1, 13 and 18 which recite a sub-system for using the operating characteristic in determining the lease rate. Thus, because Albertshofer does not disclose the claimed sub-system, Albertshofer does not teach or suggest independent claims 1, 1 and 18. The rejection of independent claims 1, 13 and 18 under 35 U.S.C. § 103(a), and claims 2-7, 14-17, 12 and 21-24, dependent therefrom, is reversed.

We turn next to the rejection of claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Koether in view of Albertshofer and Nguyen. We cannot sustain the rejection of claim 8 because the examiner has not shown, nor do we find, that Nguyen makes up for the basic deficiencies of Koether and Albertshofer. Accordingly, the rejection of claim 8 under 35 U.S.C. § 103(a) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-8 and 12-24 under 35 U.S.C. § 103(a) is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136 (a)(1)(iv)(effective September 13, 2004; Fed. Reg. 49960 (August 12, 2004).

REVERSED

LEE E. BARRETT
Administrative Patent Judge)
)
)
)
)
)
LANCE LEONARD BARRY) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
)
)
)
STUART S. LEVY)
Administrative Patent Judge)

SSL/kis

RADER, FISHMAN & GRAUER, P.L.L.C.
39533 WOODWARD AVENUE
SUITE 140
BLOOMFIELD HILS, MI 48304-0610

This Page is Inserted by IFW Indexing and Scanning Operations and is not part of the Official Record

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ BLACK BORDERS
- ☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ☐ FADED TEXT OR DRAWING
- ☐ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ☐ SKEWED/SLANTED IMAGES
- ☐ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ☐ GRAY SCALE DOCUMENTS
- ☐ LINES OR MARKS ON ORIGINAL DOCUMENT
- ☒ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ☐ OTHER: _____

IMAGES ARE BEST AVAILABLE COPY.
As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.